



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,003	09/27/2001	Rabindranath Dutta	AUS920010684US1	2730

48916 7590  
Greg Goshorn, P.C.  
9600 Escarpment  
suite 745-9  
AUSTIN, TX 78749

02/28/2007

EXAMINER

TOMASZEWSKI, MICHAEL

ART UNIT

PAPER NUMBER

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/965,003	<b>Applicant(s)</b> DUTTA ET AL.	
	<b>Examiner</b> Mike Tomaszewski	<b>Art Unit</b> 3626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Notice To Applicant***

1. This communication is in response to the Brief On Appeal filed on 12/18/06.  
Claims 1-19 are pending.

***Brief On Appeal***

2. In view of the Appeal Brief filed on 12/18/06, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, Appellant must exercise one of the following two options:

- (A) File a reply under 37 CFR 1.111 (if this Office Action is non-final) or a reply under 37 CFR 1.113 (if this Office Action is final); or
- (B) Initiate a new appeal by filing a Notice of Appeal under 37 CFR 41.37.

The previously paid Notice of Appeal fee and Appeal Brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then

Art Unit: 3626

Appellant must pay the difference between the increased fees and the amount previously paid.

A supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud (5,845,255; hereinafter Mayaud), in view of Joao (6,283,761; hereinafter Joao), and in view of Snowden et al. (US 2002/0026332; hereinafter Snowden).

(A) As per claim 1, Mayaud discloses a method comprising:

Art Unit: 3626

- (a) receiving a patient prescription for a specified medication (Mayaud: col. 27, lines 30-39);
- (b) verifying availability of insurance coverage from an insurance company for the patient prescription (Mayaud: col. 15, lines 48-53; col. 21, lines 33-41; col. 53, lines 23-34); and
- (c) verifying an insurance payment category for the prescription (Mayaud: col. 5, lines 33-43).

Mayaud, however, fails to *expressly* disclose a method comprising:

- (d) collecting the payment from the patient based on the payment category;
- (e) transmitting the payment category and the payment to the insurance company; and
- (f) excluding the medication information.

Nevertheless, these features are old and well known, as evidenced by Joao. In particular, Joao discloses a method comprising:

- (d) collecting the payment from the patient based on the payment category (Joao: col. 37, lines 47-65);
- (e) transmitting the payment category and the payment to the insurance company (Joao: col. 37, lines 47-65; Fig. 1);

(f) excluding the medication information (Snowden: ¶ [0065], [0079], [0085]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Mayaud and Snowden with the motivation of providing a means for securing the confidentiality of patient information, in whole or in part, while making medical payments (Joao: col. 7, lines 16-24).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Snowden with the combined teachings of Mayaud and Joao with the motivation of providing a means for securing the confidentiality of patient information, in whole or in part, while making medical payments (Snowden: ¶ [0121]).

(B) As per claim 2, Mayaud discloses the method of claim 1 wherein the payment category is a brand name (Mayaud: col. 4, lines 60-65).

Examiner has noted insofar as claim 2 recites, "selected from brand name, generic, and not covered," brand name has been recited.

(C) As per claim 3, Mayaud discloses the method of claim 1 further comprising dispensing the prescription to the patient (Mayaud: abstract; col. 4, lines 29-35).

(D) As per claim 4, Mayaud discloses the method of claim 1 further comprising collecting patient preexisting prescription information and patient insurance information

Art Unit: 3626

from a storage medium (Mayaud: col. 15, lines 47-58; col. 21, lines 33-41; col. 41, lines 42-67; col. 42, lines 1-16; Fig. 12).

(E) As per claim 5, Mayaud fails to *expressly* disclose the method of claim 4 further comprising recording the prescription and the payment on the storage medium.

Nevertheless, these features are old and well known, as evidenced by Joao. In particular, Joao discloses the method of claim 4 further comprising recording the prescription and the payment on the storage medium (Joao: col. 16, lines 33-65; col. 17, lines 25-67; col. 18, lines 1-33; col. 19, lines 7-67; col. 20, lines 1-8; col. 37, lines 47-65; Fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the teachings of Mayaud with the motivation of providing an apparatus and method for processing and/or providing healthcare information and/or healthcare-related information for facilitating a variety of healthcare applications (Joao: col. 8, lines 3-14).

(F) As per claim 6, Mayaud discloses the method of claim 1 further comprising checking for adverse reactions between the patient prescription and at least one preexisting patient prescription (Mayaud: col. 31, lines 18-67; col. 32, lines 1-21).

(G) Claim 8 differs from method claim 1 by reciting "a computer product in a computer readable medium" within its preamble. As per these elements, Mayaud's

Art Unit: 3626

patient information management system includes computers, databases, interfaces, and gateway-routers, among other components (Mayaud: col. 45, lines 7-67; col. 46, lines 1-67; col. 47, lines 1-10; Fig. 16). As such, it is readily apparent that Mayaud's patient information management system is controlled by a computer product in a computer readable medium."

The remainder of claim 8 substantially repeats the same limitations of method claim 1 and is therefore, rejected for the same reasons given above for claim 1, and incorporated herein.

(HI) Claims 9-13 substantially repeat the same limitations of claims 2-6 and are therefore, rejected for the same reasons given for those claims.

(I) Claim 14 differs from method claim 1 by reciting hardware elements, namely, a receiving means, a first verifying means, a second verifying means, a collecting means, and a transmitting means. As per these elements, it is submitted that because the teachings of Mayaud and Joao disclose the process steps recited in method claim 1, claim 1, in order to perform the process steps, discloses the aforementioned hardware elements as well. As such, claim 14 substantially repeats the same limitations of method claim 1 and is therefore, rejected for the same reasons given above for claim 1 and incorporated herein.



Art Unit: 3626

(J) Claims 15-19 substantially repeat the same limitations of claims 2-6 and are therefore, rejected for the same reasons given for those claims.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, as applied to claims 1 above, and further in view of Snowden et al. (US 2002/0026332; hereinafter Snowden).

(A) As per claim 7, Mayaud discloses a method comprising:

- (a) storing patient prescription information on a storage medium (Mayaud: col. 41, lines 42-67; col. 42, lines 1-16; Fig. 16); and
- (b) providing unlimited access to the prescription information to the patient (Mayaud: col. 7, lines 30-45; col. 8, lines 60-63).

Mayaud, however, fails to *expressly* disclose a method comprising:

- (c) providing limited access to the prescription information to third parties in response to authorization by the patient.

Nevertheless, this feature is old and well known in the art, as evidenced by Snowden. In particular, Snowden discloses a method comprising:

Art Unit: 3626

- (c) providing limited access to the prescription information to third parties in response to authorization by the patient (Snowden: abstract; ¶ [0079]).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Snowden with the teachings of Mayaud with the motivation of providing a means for securing the confidentiality of patient information (Snowden: ¶ [0121]).

### ***Response to Arguments***

- 6. Appellant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


- 7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

Art Unit: 3626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER